



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,859	10/31/2003	Jacqueline Ann Lewchenko	36135-400100	2858

27717 7590 09/25/2006

SEYFARTH SHAW LLP
131 S. DEARBORN ST., SUITE2400
CHICAGO, IL 60603-5803

EXAMINER

MERCIER, MELISSA S

ART UNIT	PAPER NUMBER
----------	--------------

1615

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/605,859

Applicant(s)

LEWCHENKO, JACQUELINE ANN

Examiner

Melissa S. Mercier

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10-31-03, 4-10-06.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, Claims 1-8 in the reply filed on 7-20-2006 is acknowledged. The traversal is on the ground(s) that all claims rely on the particulars of Group I for patentability. This is not found persuasive because claims 9-11 are drawn to a nail application composition while claims 1-8 are drawn to a composition. The searches for the distinct groups would not overlap.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-11 are pending in this application. Claims 9-11 are withdrawn from consideration. Claims 1-8 are rejected.

Information Disclosure Statement

Receipt of the Information Disclosure Statements filed on 10-31-2003 and 4-10-2006 is acknowledged.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Perricone et al. (US Patent 6,162,419).

Art Unit: 1615

Perricone teaches a composition suitable for topical use comprising "fatty acid esters of ascorbic acid, particularly saturated fatty acid esters such as ascorbyl palmitate, their salts, ascorbic acid and its salts. Useful solvents include polyethylene glycol, ethoxydiglycol, propylene glycol, butylene glycol, propylene carbonate, glycerin, a capric glyceride, a caprylic glyceride, an alkyl lactate, an alkyl adipate, an isosorbide, and mixtures thereof" (abstract). Additionally, "the solvent or solvent mixtures are selected to be conducive to topical application, and ones that form a film or layer on the skin to which the composition is applied so as to localize the application and provide some resistance to washing off by immersion in water or by perspiration and/or one which aids in percutaneous delivery and penetration of the ascorbyl fatty acid ester into lipid layers are particularly preferred. In many embodiments, compositions of the invention contain a penetration enhancer such as oleic acid and/or urea; typical concentrations range from about 0.5% to about 10% by weight. Compositions may also contain acrylate/meteth copolymers(column 5, lines 22-34).

Perricone's example of a "7% cream comprising:

Urea (film former) and 0.64% weight/weight Gotu Kola Extract" (column 9, lines 15-39).

Regarding Claims 2-3, Perricone's example of the 7% cream comprises 0.64% weight/weight Gotu Kola Extract" (column 9, line 38).

Regarding Claim 7, Perricone's example of the 7% cream comprises carbomer, which is a known polymer of acrylic acid, used as an emulsifier or thickening agent (column 9, line 17) and polysorbate-20, which is a known emulsifier or viscosity controlling agent (column 9, line 28).

Art Unit: 1615

Regarding Claim 8, ascorbic acid is also known as Vitamin C, additionally, Perricones example of the 7% cream further comprises tocopherol acetate or vitamin E. (column 9, line 29).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, and 4-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Perricone et al. (US Patent 6,162,419) in view of Cook (US Patent 5,985,951).

Perricone's teachings as they apply to Claim 1 are discussed above and applied in the same manner.

Perricone does not teach the use of plasticizers, UV radiation absorbers, and pigments.

Art Unit: 1615

Cook teaches, "an improved cosmetic employing a coloring agent and a plasticizer in a volatile solvent includes a film-forming agent, as well as a cosmetic pigment"(abstract). The composition can further comprise "ultraviolet absorbers; UV light stabilizers; tinting pigments; thickening agents; or coalescing agents" (column 9, lines19-29).

It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. As shown by the recited teachings, instant claims are no more than the combination of conventional components typically found in topical cosmetic compositions. It therefore follows that the instant claims define prime facie obvious subject matter. Cf. In re Kerhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1615

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MSMercier



MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600